

## REMARKS

This Response is submitted in reply to the Office Action dated May 18, 2004. Claims 1, 31, and 34 have been amended for clarification purposes and not for any reasons of patentability. No new matter has been added by these amendments.

A Petition for a Three-Month Extension of Time to respond to the Office Action and a Request for Continued Examination are submitted herewith. A check in the amount of \$980.00 is submitted herewith to cover the cost of the Extension. A check in the amount of \$790.00 is submitted herewith to cover the cost of the RCE. Please charge Deposit Account No. 02-1818 for any insufficiency of payment or credit for any overpayment.

In the Office Action:

- (1) Claims 1, 4, 7, 9, 10, 12, 13, 15, 17, 20, 22, 31, and 34 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,439,993 to O'Halloran ("*O'Halloran*");
- (2) Claims 25 to 28, 32, and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *O'Halloran*; and
- (3) Claim 3 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *O'Halloran* in view of U.S. Patent No. 6,551,187 to Jaffe ("*Jaffe*").

Regarding the § 102(e) rejection of Claims 1, 4, 7, 9, 10, 12, 13, and 15 as being anticipated by *O'Halloran*, Applicants respectfully disagree with and traverse this rejection.

Amended Claim 1 relates to a method for operating a slot machine including a plurality of reels and a plurality of symbols on the reels. Among other elements, the method includes randomly generating on a plurality of paylines associated with the reels a first set of the symbols from the plurality of symbols. The first set includes a plurality of symbols generated on each of a plurality of the reels, where each of the symbols in the first set of symbols is adapted for individual replacement. All of the plurality of the symbols generated on one of the reels are selected for individual replacement, and each selected symbol in the first set is individually replaced with one of the plurality of

symbols to generate a second set of the symbols. The second set of symbols is displayed in place of the first set of symbols.

*O'Halloran* does not expressly or inherently disclose replacing each selected symbol from a first set of symbols on a plurality of paylines. Instead, *O'Halloran* discloses the appearance of an original triggering wild card on one of the reels on a win line. (*O'Halloran*, col. 1, lines 37 to 40). After the appearance of the triggering wild card, wild cards can be caused to substitute in other reels on the same contiguous win line. (*O'Halloran*, col. 1, line 47 to 54; col. 3, lines 7 to 9). *O'Halloran* conditions the appearance of additional wild cards upon display of an original triggering wild card. (*O'Halloran*, col. 2, lines 61 to 64). Even if the condition is met and even if the player defines more than one win line, additional wild cards may be caused to substitute only on adjacent reels so as to be contiguous on a win line with the first triggering wild card. (*O'Halloran*, col. 1, lines 48 to 50; col. 2, lines 50 to 53; col. 3, lines 5 to 8). On the other hand, amended Claim 1 has, among other elements, the element in which all of the plurality of symbols generated on one of the reels in the first set is selected for individual replacement. That is, the selected symbols are all on the same reel. Furthermore, rather than a condition of an original, triggering wild card, amended Claim 1 has the element in which selected symbols in the first set are each replaced with one of the plurality of symbols to generate a second set of the symbols.

Under § 102(e), a claim can be anticipated only when the same device or method having all of the elements contained in the claim is described in a single prior art reference. *Crown Operations Int'l Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 1375, 62 U.S.P.Q.2d 1917, 1921 (Fed. Cir. 2002). An anticipating reference must describe the claimed subject matter with sufficient clarity and detail to establish that the subject matter existed in the prior art and that such existence would be recognized by persons of ordinary skill in the field of the invention. *Id.* The law is well-settled that it is not sufficient for an office action to merely allege, without support, the existence of inherency. The office action must provide an exact citation which explains the basis of the inherency rejection. See *In re Yates*, 663 F.2d 1054, 1057, 211 U.S.P.Q. 1149, 1151 (C.C.P.A. 1981) (when the PTO asserts that there is an explicit or implicit teaching

or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference). The office action does not provide such a citation in this instance which supports the § 102(e) rejection.

Additionally, when anticipation is based on inherency of elements not expressly disclosed in the anticipating reference, it must be shown that the undisclosed information was known to be present in the subject matter of the reference. *Elan Pharm., Inc. v. Mayo Found. for Med. Educ. & Research*, 304 F.3d 1221, 1228, 64 U.S.P.Q.2d 1292, 1296 (Fed. Cir. 2002). It is respectfully submitted that the Office Action has improperly rejected the claims in the present application because the Office Action does not establish a *prima facie* case of anticipation under 35 U.S.C. § 102(e). "Inherency 'may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *Crown Operations*, 289 F.3d at 1377, 62 U.S.P.Q.2d at 1923, *quoting In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981). Inherent anticipation requires that the missing descriptive material must be necessarily present, not merely probable or possibly present in the prior art. *Rosco, Inc. v. Mirror Lite Co.*, 304 F.3d 1373, 1380, 64 U.S.P.Q.2d 1676 (Fed. Cir. 2002).

The Federal Circuit in *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999) stated that to establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *quoting Cont'l Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991). The Court in *Robertson* ruled that the Board of Patent Appeals ignored these principles when the Board found that the proposed claim was inherent in a prior art reference. *In re Robertson*, 169 F.3d at 745, 49 U.S.P.Q.2d at 1951. The Court stated that the Board made no attempt to show that the missing elements were "necessarily" disclosed in the prior art reference and cited no extrinsic evidence so indicating. *Id.* The Court held that the Board's theory that two devices in the prior art reference which were capable of being intermingled to perform the same function as the elements in the claims was insufficient to show that the latter device was

inherent in the prior art reference. *Id.* The Court reasoned that the Board's analysis rested upon the very kind of probability or possibility which is insufficient to establish inherency. *Id.* For at least these reasons, Applicants respectfully submit that amended Claim 1 is patentably distinguished over *O'Halloran* and is in condition for allowance.

*O'Halloran* does not expressly or inherently disclose the element in dependent Claim 4 of individually replacing the selected symbols without spinning the reels. For at least this reason, Applicants respectfully submit that Claim 4 is patentably distinguished over *O'Halloran* and is in condition for allowance. Additionally, Claim 4 depends directly from allowable, amended Claim 1 and is in condition for allowance for the reasons discussed above for amended Claim 1 and because of additional recited features.

*O'Halloran* does not expressly or inherently disclose the element in dependent Claim 7 of generating the first set of symbols and second set of symbols as part of a bonus game. For at least this reason, Applicants respectfully submit that Claim 7 is patentably distinguished over *O'Halloran* and is in condition for allowance. Additionally, Claim 7 depends directly from allowable, amended Claim 1 and is in condition for allowance for the reasons discussed above for amended Claim 1 and because of additional recited features.

*O'Halloran* does not expressly or inherently disclose the element in dependent Claim 9 of replacing each selected symbol in the first set with a wild symbol which functions as one of the plurality of symbols. Instead, *O'Halloran* requires the appearance of an original, triggering wild card to cause substitution of any of the symbols. (*O'Halloran*, col. 1, lines 38 to 41 and 50 to 54). For at least this reason, Applicants respectfully submit that Claim 9 is patentably distinguished over *O'Halloran* and is in condition for allowance. Additionally, Claim 9 depends directly from allowable, amended Claim 1 and is in condition for allowance for the reasons discussed above for amended Claim 1 and because of additional recited features.

*O'Halloran* does not expressly or inherently disclose the element in dependent Claim 10 of replacing each selected symbol in the first set with a wild symbol wherein each wild symbol sequentially functions as at least one of the plurality of symbols. Instead, as discussed above for Claim 9, *O'Halloran* requires the appearance of a

triggering wild card to cause substitution of any of the symbols. (*O'Halloran*, col. 1, lines 38 to 41 and 50 to 54). For at least this reason, Applicants respectfully submit that Claim 10 is patentably distinguished over *O'Halloran* and is in condition for allowance. Additionally, Claim 10 depends directly from allowable amended Claim 1 and is in condition for allowance for the reasons discussed above for amended Claim 1 and because of additional recited features.

*O'Halloran* does not expressly or inherently disclose the element in dependent Claim 12 of replacing each selected symbol including individually replacing one of the other symbols on a plurality of reels wherein the symbol functions as one of the plurality of symbols. For at least this reason, Applicants respectfully submit that Claim 12 is patentably distinguished over *O'Halloran* and is in condition for allowance. Additionally, Claim 12 depends directly from allowable amended Claim 1 and is in condition for allowance for the reasons discussed above for amended Claim 1 and because of additional recited features.

*O'Halloran* does not expressly or inherently disclose the element in dependent Claim 13 of individually replacing each selected symbol in the first set including substituting a wild symbol for at least one symbol on another one of the reels wherein each wild symbol functions as one of the plurality of symbols. For at least this reason, Applicants respectfully submit that Claim 13 is patentably distinguished over *O'Halloran* and is in condition for allowance. Additionally, Claim 13 depends from allowable amended Claim 1 and is in condition for allowance for the reasons discussed above for amended Claim 1 and because of additional recited features.

*O'Halloran* does not expressly or inherently disclose the element in dependent Claim 15 of replacing each selected symbol in the first set including substituting a wild symbol for least one of the other symbols in a row of symbols along a plurality of reels wherein the wild symbol functions as one of the plurality of symbols. Instead, as discussed above for Claim 9, *O'Halloran* requires the appearance of a triggering wild card to cause substitution of any of the symbols. (*O'Halloran*, col. 1, lines 38 to 41 and 50 to 54). For at least this reason, Applicants respectfully submit that Claim 15 is patentably distinguished over *O'Halloran* and is in condition for allowance. Additionally,

Claim 15 depends directly from allowable, amended Claim 1 and is in condition for allowance for the reason discussed above for amended Claim 1 and because of additional recited features.

Regarding the § 102(e) rejection of Claims 17, 20, and 22 as being anticipated by *O'Halloran*, Applicants respectfully disagree with and traverse this rejection. Claim 17 relates to a method for operating a gaming device including a plurality of reels and a plurality of symbols on the reels. Among other elements, the method includes generating a first set of the symbols on the reels, wherein one of the symbols in the first set is a first wild symbol which functions as one of the other symbols. The first set of the symbols includes a plurality of generated symbols on each of a plurality of the reels. All of the plurality of symbols generated on one of the reels in the first set, except for the first wild symbol, are selected for individual replacement. Each of the selected symbols is replaced with a second wild symbol to create a second set of symbols that is displayed in place of the first set of symbols.

*O'Halloran* does not expressly or inherently disclose generating a first set of symbols on a plurality of reels wherein one of the symbols in the first set is a first wild symbol in combination with selecting all of the plurality of symbols generated on one of the reels in the first set, except for the first wild symbol, and replacing each selected symbol on that reel with a second wild symbol. Instead, *O'Halloran* discloses a trigger wild card that can appear in one of the reels on a win line. (*O'Halloran*, col. 1, lines 37 to 40). The appearance of the trigger wild card can cause one or more further wild cards to substitute on the same, contiguous line, adjacent to the trigger wild card. (*O'Halloran*, col. 1, lines 37 to 43 and 49 to 54; col. 3, lines 7 to 9). *O'Halloran* causes the appearance of additional wild cards to the same contiguous win line on which the first wild card appears and also conditions the appearance of additional wild cards on the appearance of the trigger wild card. On the other hand, in the method of Claim 17, all of the plurality of symbols generated on one of the reels in the first set, except for the first wild symbol, are selected for individual replacement. Each of the selected symbols are all on the same reel. Each of the selected symbols is replaced with a second wild symbol to create a second set of symbols that is displayed in place of the first set of

symbols. For at least these reasons, Applicants respectfully submit that Claim 17 is patentably distinguished over *O'Halloran* and is in condition for allowance.

Claims 20 and 22 depend directly from amended Claim 17 and are also in condition for allowance for the reasons discussed above for amended Claim 17 and for additional features recited in these claims.

Regarding the § 102(e) rejection of Claim 31 as being anticipated by *O'Halloran*, Applicants respectfully disagree with and traverse this rejection. Amended Claim 31 relates to a method for determining an award in a slot machine including a plurality of reels, a plurality of symbols on the reels, and a plurality of award yielding combinations of the symbols. Among other elements, the method includes randomly generating on a plurality of paylines associated with the reels a first set of said symbols including a plurality of symbols on each of a plurality of reels. The first set is evaluated to determine if any award yielding symbol combinations are displayed and an award is provided to a player for each award yielding symbol combination appearing in the first set on any of the paylines. A plurality but not all of the symbols in the first set is selected for individual replacement whether or not any award yielding symbol combinations are displayed in the first set, wherein the selected symbols are at least two predetermined symbols on the reels. Each selected symbol is individually replaced with one of the symbols to create a second set of symbols that is displayed in place of the first set of symbols. The second set is evaluated to determine if any award yielding symbol combinations are displayed and an award is provided to the player for each award yielding symbol combination appearing in the second set on any of said paylines including all award yielding symbol combinations in the second set even if an award was provided for such award yielding combinations in the first set.

*O'Halloran* does not expressly or inherently disclose selecting a plurality but not all of the symbols in a first set for individual replacement whether or not any award yielding symbol combinations are displayed in the first set, and replacing each selected symbol to create a second set of symbols that is displayed in place of the first set of symbols. Instead, *O'Halloran* discloses a trigger wild card that can appear in one of the reels on a win line which can cause one or more further wild cards to substitute adjacent



to the trigger wild card. (*O'Halloran*, col. 1, lines 37 to 43; col. 3, lines 7 to 9). That is, *O'Halloran* discloses that additional wild cards can appear only after the appearance of the trigger wild card. On the other hand, in the method of amended Claim 31, the symbol selection and individual replacement of the selected symbols in the first set is not dependent upon which symbols comprise the first set. Unlike *O'Halloran*, the method of amended Claim 31 has the element of selecting a plurality of symbols and individually replacing the selected symbols in the first set to create a second set of symbols whether or not any award yielding symbol combinations are displayed in the first set.

Therefore, *O'Halloran* does not expressly disclose all of the elements of amended Claim 31, nor are all the elements inherently disclosed in *O'Halloran*. For at least these reasons, Applicants respectfully submit that amended Claim 31 is patentably distinguished over *O'Halloran* and is in condition for allowance.

Regarding the § 102(e) rejection of Claim 34 as being anticipated by *O'Halloran*, Applicants respectfully disagree with and traverse this rejection. Amended Claim 34 is directed to a slot machine. Among other elements, the slot machine includes a plurality of reels, a plurality of paylines with the reels, a plurality of symbols on the reels including a wild symbol functioning as at least one other non-wild symbol, and a plurality of symbol combinations that each yield an award. A processor controls the reels and causes the reels to generate a first set of the symbols along the paylines including a plurality of symbols on each of a plurality of the reels. The processor substitutes another one of the non-wild symbols in the first set with another wild symbol at each of the plurality of generated symbols on the reel with the wild symbol to create a second set of symbols that is displayed in place of the first set of symbols.

*O'Halloran* does not expressly or inherently disclose substituting the non-wild symbols in a first set with another wild symbol at each of the plurality of generated symbols on the reel with the wild symbol to create a second set of symbols that is displayed in place of the first set of symbols. *O'Halloran* discloses the appearance of an original, triggering wild card on one of the reels on a win line. (*O'Halloran*, col. 1, lines 37 to 40 and 50 to 54). After the appearance of the triggering wild card, wild cards can



be caused to substitute in other reels on the same, contiguous win line. (*O'Halloran*, col. 1, line 47 to 54; col. 3, lines 7 to 9). Additionally, *O'Halloran* conditions the appearance of additional wild card symbols upon display of the first, trigger wild card. (*O'Halloran*, col. 2, lines 61 to 64). Even if the condition is met and even if the player defines more than one win line, additional wild cards may appear only on the same, contiguous win line as the first wild card symbol. (*O'Halloran*, col. 1, lines 48 to 50; col. 3, lines 5 to 8). On the other hand, amended Claim 34 has, among other elements, the element in which the non-wild symbols at each of a plurality of generated symbols on the reel with the wild symbol are substituted with another wild symbol to create a second set of symbols that is displayed in place of the first set of symbols. The substituted symbols are on the same reel. Furthermore, the symbol replacement event of amended Claim 34 is not conditional on which symbols comprise the first set. For at least these reasons, Applicants respectfully submit that amended Claim 34 is patentably distinguished over *O'Halloran* and is in condition for allowance.

Regarding the § 103(a) rejection of Claims 25 to 28, 32, and 35 as being unpatentable over *O'Halloran*, Applicants respectfully traverse this rejection. Applicants respectfully submit that *O'Halloran* is not prior art to the present invention under 35 U.S.C. § 103(a) based on 35 U.S.C. § 103(c).

The present invention is now assigned to IGT, 9295 Prototype Drive, Reno, Nevada 89511, and was subject to an obligation of assignment to IGT at the time the invention was made. Enclosed herewith is a copy of the Notice of Recordation of Assignment from Inventors/Assignors William J. Bussick, Paulina Glavich, and Anthony J. Baerlocher to Assignee IGT, recorded on January 25, 2001, on Reel 011479, Frame 0012. *O'Halloran* was subject to an obligation of assignment to I.G.T. (Australia) Pty Limited at the time the invention was made and is now assigned to I.G.T. (Australia) Pty Limited. I.G.T. (Australia) Pty Limited is presently, and was at the time both the invention of *O'Halloran* and the present invention were made, a wholly-owned subsidiary of International Game Technology, the parent corporation and owner of IGT. (see enclosed copies of IGT and IGT (Australia) corporate profiles printed from:

1. <http://www.igt.com/BusinessDivisions/default.asp?pid=25>;

2. <http://www.igt.com/BusinessDivisions/default.asp?pid=25.117&bhcp=1>; and
3. <http://www.igt.com.au/articles/article.asp?ID=1>).

Accordingly, IGT and I.G.T. (Australia) Pty Limited are affiliated corporations which qualify under 35 U.S.C. § 103(c) and *O'Halloran* is not prior art under 35 U.S.C. § 103(c). For at least this reason, Applicants respectfully submit that Claims 25 to 28, 32, and 35 are in condition for allowance.

Regarding the § 103(a) rejection of Claim 3 as being unpatentable over *O'Halloran* in view of *Jaffe*, Applicants respectfully traverse this rejection. *O'Halloran* is not prior art under 35 U.S.C. § 103(c) and Applicants respectfully submit that Claim 3 is also in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicants respectfully request that the Examiner contact the undersigned.

Respectfully submitted,

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Dated: November 17, 2004



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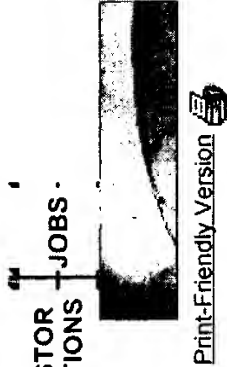
The IGT Gaming division encompasses product and systems development, MegaJackpots™ wide area progressives, proprietary gaming products, sales, and casino services.

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In addition to its North American locations, IGT maintains sales, service and manufacturing sites around the globe - in Africa, Asia, Australia, Europe, and South America. IGT's international machine sales are comprising more and more of the company's total sales numbers.



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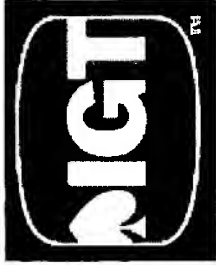
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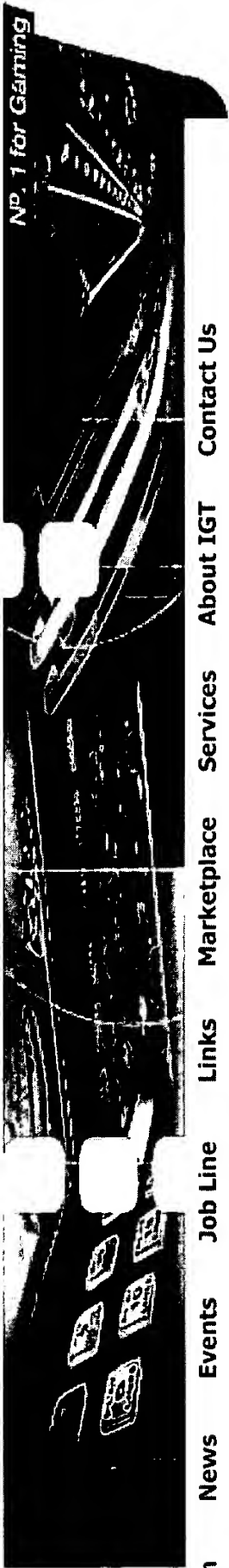
## International Group

In addition to its North American locations, IGT maintains sales, service and manufacturing sites around the globe - in Africa, Asia, Australia, Europe, and South America. IGT's international machine sales are comprising more and more of the company's total sales numbers.

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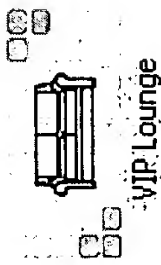
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## Corporate Profile

International Game Technology is renowned as the world leader in the design, development and manufacture of microprocessor based gaming products.

Today IGT is a **Fortune 500 company** with approximately **80% of the US market** and **more than half a million gaming machines** in place around the world.

**IGT's global vision** has helped the company to expand internationally through manufacturing and sales in Australia, Japan and the UK, as well as sales and service offices in Argentina, Brazil, the Netherlands, Japan, South Africa and Peru, and we continue to make inroads in legal gaming jurisdictions worldwide.

IGT's reputation as the **world's leading gaming machine maker**, and it's status on the New York Stock Exchange, are built on the willingness to deliver what customers want.

The corporate headquarters of IGT is in Reno, Nevada in the USA where it employs over 2000 people. That's a serious number of jobs! Worldwide IGT has 32 sales and service offices and is licensed to conduct business in every legal gaming jurisdiction in the world.

IGT (Australia) or IGTA is a wholly owned subsidiary of International Game Technology which began operations in 1986. IGTA has since grown and operates a number of sales and distribution offices throughout Australia such as Brisbane, Adelaide, Newcastle and Albury.

Since its introduction into the competitive Australian gaming market IGTA has continually been a major player by delivering exciting games, expert sales service, and professional gaming support and advice.

IGTA's manufacturing strategy involves leveraging off of Reno's extensive manufacturing capabilities so the Australian operation can give even greater focus to innovative sales, service and game design.

In 2003, IGT Australia received the Award for Excellence in People Management by the Australian Human Resources Institute. **Click here** to read more about the award.